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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILL H. GARDENSWARTZ, DAVID W. BANKER, and
MELISSA B. GOIDEL

Appeal 2007-2767
Application 09/893,775
Technology Center 3600

Decided:¹ March 30, 2009

Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and
JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

I. Appellants have filed a Request for Rehearing under 37 C.F.R. § 41.52(a)(3) (2007) of our Decision of November 4, 2008. The Decision

¹The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

affirmed the Examiner's rejections of claims 1, 55, and 57-87. In so doing, the Decision affirmed the rejection of claim 1 under 35 U.S.C. § 103(a) Biorge in view of Stein and Herz, but used a different rationale than that applied by the Examiner.

Thus, Appellants seek a modification of our Decision to designate it as a new ground of rejection under 37 C.F.R. § 41.50(b).

Upon review of Appellants' arguments submitted in the Request, we grant the request for rehearing to the extent that we denominate the Decision a new ground of rejection under 37 C.F.R. § 41.50(b).

II. Appellants also maintain the panel erred in not defining a prima facie case for the rejection of claim 1, and thus seek further statements establishing what they believe is a new ground of rejection (Request 4).

First, from the Request there appears to be some confusion as to what the Decision did. We take the Appellants' statement "...motivation to modify [(sic)] in view of Stein and Biorge..." (Request 4) to mean that Appellants seem to think Stein is being modified in view of Biorge. If this is Appellants' understanding, then it is incorrect. The Decision states:

Stein discloses the use of a host computer which tracks purchase history of a consumer on a national basis at brick and mortar stores (e.g., off line purchases) and updates a database so that the database is current at whatever store the consumer purchases (FF 2). To use a computer, such as host computer 13 in Stein, in conjunction with the first computer or portable device in Biorge to create a centralized database which accounts for offline purchases and causes the involved consumer to receive updated advertisements or coupons (FF 3,4) based on all purchases would be a predictable variation to the Biorge system.

(Decision 11-12.) Thus, from this statement it should be understood that the Examiner's rejection remains intact except for modifying Biurge to include a computer, such as host computer 13 in Stein, which tracks purchase history of a consumer on a national basis at brick and mortar stores (e.g., off line purchases) in conjunction with the first computer or portable device in Biurge to create a centralized database which accounts for offline purchases and causes the involved consumer to receive updated advertisements or coupons.

This said, Appellants assert that our change in rationale requires us to "provide the motivation for the claimed association noted in claim 1" and, likewise, for the Examiner to do so in the rejections presented to the Board on first instance. (Request 5.) We disagree with Appellants.

First, our Decision does not change the combination used by the Examiner in the rejection, i.e., Biurge in view of Stein and Herz, remains as set forth by the Examiner. Based on this combination, we applied a different rationale from that used by the Examiner. This did not affect the Examiner's original use of Biurge as the primary reference and Stein as the secondary reference as supported by the Examiner's articulated reasoning that:

Stein et al. teaches that the first identifier (user code, col. 2 lines 65-66) is associated by a purchase behavior classification with the observed purchase history of a consumer (col. 2 line 66 to col. 3 line 8). Because classification is statistically efficient, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Stein et al. to those of Biurge et al.

(Non-Final Rej. (dated: Feb. 27, 2006) 3; see also Answer 4.)

Second, to the extent Appellants seek an explicit suggestion or motivation in the reference itself, this is no longer the law in view of the Supreme Court's recent holding in *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). Since, as shown above, the Examiner has provided some articulated reasoning with some rational underpinning for why a person with ordinary skill in the art would modify Biorge with the teachings of Stein, Appellants' argument is not persuasive as to error in the rejection.

Next, Appellants argue “[w]here does the offline system obtain correspondence of the portable device of Biorge with the identify [(sic., identity)] of the customer whose offline purchase history is stored by Stein?” (Request 4.) Again the argument wrongly seems to assume the modification occurs to Stein and, not as proposed by the Examiner, to Biorge. As set forth above, the record shows that the Examiner quite articulately described how Stein discloses correspondence between customer identity and purchase history. This was never challenged by Appellants in their Appeal Brief and Appellants should not now be using the reconsideration process as a vehicle to present an argument they did not make in their Brief.² All that our

² The Request for Reconsideration also seeks our consideration of claim 55 with respect to how Stein discloses the claimed identifiers. The Appellants assert that this request somehow is tied to their challenge to show motivation to combine Biorge and Stein as set forth on page 10, subsection b of their Appeal Brief. But, page 10 subsection b challenges motivation for combining Biorge and Stein, and claim 55 deals with the combination of Stein and Merriman. The record shows the Examiner made the requested findings sought here by Appellants for claim 55 in his Rejection dated February 27, 2006 at page 4. Appellants failed to specifically challenge such in their Appeal Brief. Arguments which Appellants could have made but chose not to make in the Briefs are not considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2007).

Decision does to the rejection of claim 1 is take from Stein the additional teaching of using brick and mortar sales data, instead of online sales data which Appellants argued only exists in Biorge. The remainder of the Examiner's rejection remains intact.

For the reasons above, we are not convinced that Appellants have shown with particularity points believed to have been misapprehended or overlooked by the Board in rendering its earlier decision. Accordingly, Appellants' request for rehearing insofar as Appellants seeks an establishment error in the Decision of the Board is denied.

CONCLUSIONS OF LAW

We conclude:

Our decision to affirm the decision of the Examiner to reject the claims on appeal under 35 U.S.C. § 103(a) over the prior art has not been shown to have been erroneous. Because in so affirming we used a different rationale than that articulated by the Examiner, we grant the request for rehearing to the extent that we denominate the Decision a new ground of rejection under 37 C.F.R. § 41.50(b).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

**REHEARING GRANTED AS TO DEMONINATING A NEW GROUND
UNDER 37 CFR 41.50(b)**

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Application 09/893,775

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